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EXAMINER

RHEE, JANE J

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/903,795
Filing Date: July 11, 2001
Appellant(s): JOHNSON, STANLEY C.

**MAILED
MAR 20 2007
GROUP 1700**

Marger Johnson and McCollom, P.C.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/6/2005 appealing from the Office action mailed 5/2/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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4844763	Robbins	7-1989
5071688	Hoffman	12-1991
5569505	Nichols	10-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 24-35, 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talbot et al. in view of Robbins (4844763) in further view of Hoffman (5071688).

Talbot et al. discloses a wood product comprising an elongate composite substrate (figure 1 number 20), a core defining the interior of the substrate (figure 1 number 24), an elongate front surface formed on one side of the substrate (figure 1 number 35), an elongate rear surface formed on the other side of the substrate (figure 1 number 37) a pair of opposing edge surfaces extending between the front and rear surfaces (figure 1 number 27), the core being exposed on the edge surfaces (figure 1 number 24), veneer substantially covering and adhered to all of the front surface, the side surfaces, and at least a portion of the rear surface adjacent at least one of the edge surfaces (figure 1 number 27, 31, and 35), the covered portion being substantially all of

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the trim that is visible when the trim is installed in on the building (figure 1 numbers 35,27,31). Talbot et al. discloses an adhesive spread between substantially all of the veneer and the substrate (col. 1 lines 40-44). Talbot et al. discloses that the trim is fixedly mounted on the building (col. 1 lines 13-14). Talbot et al. discloses that the rear surface includes a mounting surface that flushly abuts the building when the trim is mounted thereon (figure 1 number 37). Talbot et al. discloses that the substrate comprises an engineered wood product (col. 4 lines 3-4). Talbot et al. discloses that the substrate has a substantially rectangular cross section (figure 1 number 24). Talbot discloses that the veneer covers a portion of the rear surface adjacent both of the edge surfaces (figure 1 numbers 35,27). Talbot et al. discloses engineered wood product that comprises fiberboard and wherein the front surface comprises a top surface of the fiberboard and the edge surface comprises an edge of he fiberboard (col. 4 line 4). Talbot et al. discloses that at least one edge surface is substantially planar (figure 1 number 26).

Talbot et al. fail to disclose a treated paper covering the surfaces of the trim product.

Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets (col. 7 lines 15-19) for the purpose of providing improved dimensional stability of laminated veneer lumber that can be made on conventional apparatus as a commercially acceptable production rate (col. 2 lines 65- col. 3 lines 1-2).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Talbot et al. with a treated paper covering in order to provide improved dimensional stability of laminated veneer lumber that can be made on conventional apparatus as a commercially acceptable production rate (col. 2 lines 65- col. 3 lines 1-2) as taught by Robbins.

Talbot et al. and Robbins fail to disclose a resin treatment formed on at least the exposed surface of the paper. Talbot et al. and Robbins fail to disclose that the engineered wood product comprises laminated veneer lumber wherein the front surface comprises a surface on an outer veneer of the substrate and the edge surfaces comprises edges of veneer layers in the laminate veneer lumber. Talbot et al. and Robbins fail to disclose that the laminated veneer lumber comprises plywood.

Hoffman teaches a resin treatment formed on at least the exposed surface of the veneer (col. 2 lines 7-9) for the purpose of obtaining a planar smooth surface (col. 2 lines 10-11). Hoffman teaches that the engineered wood product comprises laminated veneer lumber, plywood wherein the front surface comprises a surface on an outer veneer of the substrate and the edge surfaces comprises edges of veneer layers in the laminate veneer lumber (figure 5 col.2 lines 27-29) for the purpose of cost saving (col. 1 line 33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Talbot et al. with a resin treatment formed on at least the exposed surface of the paper in order to obtain a planar smooth surface (col. 2 lines 10-11) as taught by Hoffman.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Talbot et al. with the engineered wood product that comprises laminated veneer lumber, plywood wherein the front surface comprises a surface on an outer veneer of the substrate and the edge surfaces comprises edges of veneer layers in the laminate veneer lumber in order to be cost saving (col. 1 line 33) as taught by Hoffman.

As for the wood product comprising siding or fascia, using the wood product as siding or fascia is an intended use and it has been held that a recitation with respect to the manner in which the claimed article is intended to be employed does not differentiate the claimed article from a prior art claimed article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

As to the new limitation, "wood product for use as exterior trim on the exterior of a building" is an intended use. It has been held that a recitation with respect to the manner in which the claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

2. Claims 36 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talbot et al. and Robbins (4844763) and Hoffman (5071688) in view of Nichols (5569505).

Talbot et al., Robbins, and Hoffman discloses the wood product described above. Talbot et al., Robbins, and Hoffman fail to disclose that at least one edge surface is

substantially nonplanar. Nichols teaches that at least one edge surface is substantially nonplanar (figure 1 number 24) for the purpose of providing an aesthetically pleasing panel edge appearance (col. 3 lines 41-42).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Talbot et al. with at least one edge surface that is substantially nonplanar in order to provide an aesthetically pleasing panel edge as taught by Nichols (col. 3 lines 41-42).

(10) Response to Argument

1. Appellant argues that the motivation to combine Talbot with Robbins would not be obvious and cannot be found in the nature of the problem that appellant intends to solve which is identified as improving the durability and appearance of the edges of the trim product.

Talbot et al. discloses a wood product comprising an elongate composite substrate (figure 1 number 20), a core defining the interior of the substrate (figure 1 number 24), an elongate front surface formed on one side of the substrate (figure 1 number 35), an elongate rear surface formed on the other side of the substrate (figure 1 number 37) a pair of opposing edge surfaces extending between the front and rear surfaces (figure 1 number 27), the core being exposed on the edge surfaces (figure 1 number 24), veneer substantially covering and adhered to all of the front surface, the side surfaces, and at least a portion of the rear surface adjacent at least one of the edge surfaces (figure 1 number 27, 31, and 35), the covered portion being substantially all of

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the trim that is visible when the trim is installed in on the building (figure 1 numbers 35,27,31).

Talbot et al. fail to disclose a treated paper covering the surfaces of the trim product.

Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets (col. 7 lines 15-19) for the purpose of providing improved dimensional stability of laminated veneer lumber (col. 2 lines 65- col. 3 lines 1-2). Therefore, it would have been obvious to one having ordinary skill in the art at the time appellant's invention was made to provide Talbot et al. with a treated paper covering in order to provide improved dimensional stability of the wood product (col. 2 lines 65- col. 3 lines 1-2) as taught by Robbins.

Although, the motivation taught by Robbins may not coincide with appellant's motivation of combining a treated paper covering to the wood product which is to improve the durability and appearance of the edges of the trim product, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Appellant further argues that the combination of the wood product disclosed by Talbot et al. and the paper surface covering taught by Robbins would not be proper because it is unlikely that the addition of paper would help achieve dimensional stability.

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Appellant is assuming that the addition of paper would not achieve dimensional stability and have not given substantial facts that the addition of paper would not achieve dimensional stability. Robbins teaches that the object of his invention is to provide a dimensionally stable laminated wood panel (col. 3 lines 32-35) and further teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets (col. 7 lines 15-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time appellant's invention was made to provide Talbot with a paper covering for the purpose of obtaining dimensional stability of the wood product as taught by Robbins.

2. Appellant states that the examiner has acknowledged that Robbins does not disclose the use of a treated paper to cover the surface of the trim product and Hoffman was used to make up for Robbins' deficiency.

The examiner did not acknowledge that Robbins does not disclose the use of a treated paper to cover the surface of the trim product and use Hoffman to make up for Robbins' deficiency. In the office action page 4, examiner states that Talbot et al. and Robbins fail to disclose a *resin treatment* formed on at least the exposed surface of the paper. Hoffman teaches a resin treatment formed on at least the exposed surface of the veneer (col. 2 lines 7-9) for the purpose of obtaining a planar smooth surface (col. 2 lines 10-11). Therefore, it would have been obvious to one having ordinary skill in the art at the time appellant's invention was made to provide, Talbot et al. with a resin treatment formed on at least the exposed surface of the veneer in order to obtain a planar smooth surface (col. 2 lines 10-11) as taught by Hoffman.

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3. Appellant argues that Hoffman in combination with Talbot and Robbins teaches away from Appellant's invention in particular, Robbins does not teach or suggest that the side edges are covered with veneer.

Talbot et al. discloses a veneer substantially covering and adhered to all of the front surface, the side surfaces, and at least a portion of the rear surface adjacent at least one of the edge surfaces (figure 1 number 27,31, and 35), the covered portion being substantially all of the trim that is visible when the trim is installed in on the building (figure 1 numbers 35,27,31).

Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets (col. 7 lines 15-19) for the purpose of providing improved dimensional stability of laminated veneer lumber (col. 2 lines 65- col. 3 lines 1-2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Talbot et al. with a treated paper covering in order to provide improved dimensional stability of laminated veneer lumber (col. 2 lines 65- col. 3 lines 1-2) as taught by Robbins.

As to Appellant's argument that Hoffman in combination with Talbot and Robbins teaches away from Appellant's invention, there is no evidence supported by the appellant that the combination of Hoffman with Talbot and Robbins suggest teaching away from Appellant's invention. Appellant argues that Robbins does not teach or suggest that the side edges are covered with veneer, however as discussed above, Talbot et al. discloses that the veneer substantially covers and adheres to all of the front

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surfaces, side surfaces and at least a portion of the rear surface and Robbins teaches that paper may be substituted for the surface veneer sheet for improved dimensional stability.

4. Appellant argues that Examiner's rejection of the declaratory evidence was unreasonable. Appellant argues that the Declarations support other objective factors of non-obviousness such as commercial success, failure of others and copying.

Appellant's declaration did not disclose evidence or tests regarding the closest prior art, Talbot et al. The Pacific wood laminate that Appellant declares as the closest prior art does not commensurate with the scope of the claims as set forth in MPEP 7.16.02b. The evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Appellant discloses figures shown in exhibits B and D to express the distinction between the Pacific wood laminate and appellant's invention. However, no test were given to provide any evidence or data to show any unexpected results of appellant's invention. Therefore, the declaration was found to be inconclusive regarding the distinction between appellant's invention and the Pacific wood laminate.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Jane Rhee

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